

Applicants' claims were rejected under 35 USC 102 as being anticipated by Wengel et al. (USP 6,794,499) for the reasons set forth in the paragraph bridging pages 3 and 4 of the August 1, 2006 Office Action.

Such anticipation rejection was overcome by the arguments set forth on pages 40 to 45 of applicants' AMENDMENT UNDER 37 CFR 1.111 filed November 8, 2006, which are summarized as follows.

Formula IIa is shown at the top of column 28 of Wengel et al. As discussed in applicants' AMENDMENT UNDER 37 CFR 1.111 filed November 8, 2006, to arrive at applicants' claimed compounds from column 28, lines 17 to 28 of Wengel et al., as identified in the August 1, 2006 Office Action, a person of ordinary skill in the art would have to choose one of three of the following formulae:  $(CH_2)_{0-1}-O-(CH_2)_{1-3}$ ,  $(CH_2)_{0-1}-S-(CH_2)_{1-3}$  and  $(CH_2)_{0-1}-N(R^N)-(CH_2)_{1-3}$  (wherein  $R^N$  has nine possibilities). Such three formulae have a total of 66 possibilities. Moreover, column 28, lines 29 to 32 of Wengel et al. describe further possibilities for  $R^N$ .

Taking into consideration the many possible groups for  $R^N$  as set forth in the preceding paragraph, column 28, lines 17 to 32 of Wengel et al. disclose thousands or tens of thousands of possibilities (see column 12, line 4 to column 13, line 39 of Wengel et al.).

When considering the above-described extremely large number of possibilities encompassed in column 28, lines 17 to 32 of Wengel et al., there is no direction to arrive at applicants' ENA compounds.

Anticipation is not made out by a hindsight selection based on applicants' disclosure of many variables of a broad generic disclosure, such as in Wengel et al. In re Rushig, 145 USPQ 274, 282 (CCPa 1965).

B. Request For Corrected Form PTO-892

The July 29, 2003 Office Action included a Notice of References Cited (Form PTO-892) which cited "WO 98/39532" to Imanishi et al. This citation is incorrect. The correct citation is "WO 98/39352" (see sheet 1 of applicants' Form PTO/SB/08A dated October 31, 2001, wherein WO 98/39352 is cited). The Examiner is respectfully requested to issue a corrected Form PTO-892, wherein WO 98/39352 is set forth. This request was previously made several times during the prosecution of this application (see, for example, page 2 of the RESPONSE UNDER 37 CFR 1.116 filed May 7, 2007).

It is respectfully submitted that this paper should not  
result in any reduction of patent term adjustment.

Frishauf, Holtz, Goodman  
& Chick, P.C.  
220 Fifth Avenue, 16th Fl.  
New York, NY 10001-7708  
Tel. No. (212) 319-4900  
Fax No.: (212) 319-5101  
E-Mail Address: BARTH@FHGC-LAW.COM  
RSB/ddf

Respectfully submitted,



Richard S. Barth, Reg. No. 28,180